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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,547	11/05/2003	Hai H. Trieu	31132.163	8357
46333 7590 04/03/2008 HAYNES AND BOONE, LLP 901 Main Street Suite 3100 Dallas, TX 75202				
EXAMINER SNOW, BRUCE EDWARD				
ART UNIT 3738		PAPER NUMBER		
MAIL DATE 04/03/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/701,547

Applicant(s)

TRIEU ET AL.

Examiner

Bruce E. Snow

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 6-14, 16-44 and 46 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14, 17, 20-27, 30 and 41-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 6, 7, 9, 10, 16, 18, 19, 28, 40, 44 and 46 is/are rejected.
- 7) ☒ Claim(s) 11, 12 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 1/10/08 have been fully considered. Applicant's amendment to claim 12 overcame the objection to the drawings. Applicant's amendments overcame the art rejection anticipated by Sugiyama (5,720,474) and Hedman et al (4,759,769).

Allowable Subject Matter

Claims 11, 12, 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40, 44, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schonhoffer (6,015,436) in view of Rabbe et al (5,776,198).

Referring generally to figure 4, Schonhoffer teaches:

46. (New) An apparatus comprising:

an outer body 2 including a first vertebral interface endwall textured 12" for engagement with a first vertebral body, a lateral wall, and a chamber surrounded by the lateral wall;

an inner body 1 including a second vertebral interface endwall textured 12' for engagement with a second vertebral body and a shaft portion 5' sized to extend within the chamber; and

a tab 8' sized to extend into and translate within an elongated slot 7 to limit disengagement of the inner body from the outer body. However, Schonhoffer is silent regarding a core member sized to fit entirely within the chamber and the chamber bounded at one end by the first vertebral interface endwall. Rabbe et al also teaches an extendable vertebrae implant which uses osteosynthesis material (5:63 et seq.) in the chamber and additional elements 52 to bound the chamber. It would have been obvious to one having ordinary skill in the art to use the osteosynthesis material interpreted as a core member sized to fit entirely within the chamber and elements 52 of Rabbe et al on the apparatus of Schonhoffer with for reasoning obvious to one skilled in the art with predictable results.

Claims 4, 6, 7, 9, 10, 16, 18, 19, 28, 40, 44, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patil (4,309,777) in view of Schonhoffer (6,015,436).

Patil teaches a vertebral implant device for interposition between two vertebral bodies, the device comprising:

an outer body 12 including a chamber and a first vertebral interface endwall textured 18 for engagement with one of the two vertebral bodies;

an inner body 14 including a second vertebral interface endwall textured 22 for engagement with the other of the two vertebral bodies; and

a core member 16 positioned entirely within the chamber (when fully compressed). However, Patil fails to teach wherein the outer body includes at least one slot and the inner body includes at least one tab, and wherein the tab movably engages the slot.

Schonhoffer teaches a similar vertebral implant which is extendable using an outer body and an inner body and further uses a tab 8' and slot 7 (see figure 4). It would have been obvious to one skilled in the art to have used/tried a tab/slot configuration as taught by Schonhoffer on the implant of Patil in order to secure the inner body and outer body together preventing disengagement with predictable results and, further, would have been an obvious reversal of parts to one skilled in the art to have reversed the tab and slot such that the slot is in the outer body and the tab is on the inner body as claimed.

Regarding at least claim 6, shaft, the wall portions of element 14 is interpreted as the shaft.

Claim 16, Patil teaches circular which is interpreted as being generally oval.

Regarding claims 18-19, Patil teaches the device as described above including springs 16, however, fails to teach the core member is an elastomer or polymer or polyurethane. It would have been obvious to one having ordinary skill in the prosthetic

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art to have substituted the springs 16 of Patil with an elastomer/polymer, including the materials claimed, for their well known spring like properties with predictable results.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bes

/Bruce E Snow/
Primary Examiner, Art Unit 3738